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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,414	02/22/2005	Wolfgang Herzing	HERZING1	5100
1444 7590 03/11/2009 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			EXAMINER ABU ALI, SHUANGYI	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 03/11/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/525,414	HERZING, WOLFGANG	
	<b>Examiner</b>	<b>Art Unit</b>	
	SHUANGYI ABU ALI	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/25/2009, 09/22/2008</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of Claims*

Claims 1-12 remain for examination wherein claims 1, 4, and 7 are amended, claim 2 is canceled and claims 7-12 are withdrawn. Claims 13-16 are new.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-4, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,795,649 to Cosentino et al. in view of U. S. Patent No. 4,116,710 to Heikel.

Regarding claims 1, 3-4, 13, and 15, Cosentino et al. disclose a metallic pigment made through a method of metallization of a release film. The method is vapor and vacuum deposition. The metal comprises aluminum, copper, silicon or any compound

(i.e. alloy) comprising the foregoing metal. The pigment has a thickness of 5 nm to 50 micron (col. 7, line 53 to col. 8, line 3).

Although Cosentino et al. is silent about the specific amount of the aluminum and copper in the alloy, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to select the desired alloy element amount to have the desired the physical and chemical property of the pigment, motivated by the fact that Heikel, also drawn to flaky metallic pigment, disclose that it is known to make an alloy containing 50 percent or above of a base metal (i.e. Cu- and thus the balance is the other material in the alloy). See col. 2, lines 23-25.

The reference differs from Applicant's recitations of claims by not disclosing identical ranges. However, the reference discloses "overlapping" ranges, and overlapping ranges have been held to establish prima facie obviousness (MPEP 2144.05).

Claims 1, 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 4,116,710 to Heikel.

Regarding claims 1, 4 and 13, Heikel discloses a metallic pigment made through a method of metallization of a release film. The method is vapor and vacuum deposition. The metal comprises aluminum, copper, gold or any compound (i.e. alloy) comprising the foregoing metal. The alloys contain greater than 50 percentage of the base metal. The pigment has a thickness of up to 100 nm (col. 1, line 60 to col. 2, line 25).

The reference differs from Applicant's recitations of claims by not disclosing

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identical ranges. However, the reference discloses "overlapping" ranges, and overlapping ranges have been held to establish prima facie obviousness (MPEP 2144.05).

Claims 5-6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 4,116,710 to Heikel and further in view of U. S. Patent No. 4,622,073 to Hashizume.

Regrinding claims 5-6 and 14, Heikel discloses a copper alloy flake as applicant set forth in claim 1. But they are silent that the metal flake is coated with titanate as applicants set forth in the above claims.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to treat the metal flake with titanate, motivated by the fact that Hashizume, also drawn to metal flake being used in paint composition, disclose that metal flake coated with titanate can be useful in plastic because of the increased pigment stability (col. 2, lines 35-40).

Claims 5-6, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of U. S. Patent No. 5795649 to Cosentino et al., and U. S. Patent No. 4,116,710 to Heikel and further in view of U. S. Patent No. 4,622,073 to Hashizume.

Regrinding claims 5-6, 14 and 16, Cosentino et al. and Heikel disclose a copper alloy flake as applicant set forth in claim 1. But they are silent that the metal flake is coated with titanate as applicants set forth in the above claims.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to treat the metal flake with titanate, motivated by the fact that Hashizume, also drawn to metal flake being used in paint composition, disclose that metal flake coated with titanate can be useful in plastic because of the increased pigment stability (col. 2, lines 35-40).

### ***37 CFR 1.132***

The declaration under 37 CFR 1.132 filed 11/17/2008 is insufficient to overcome the rejection of claims set forth above because: The newly cited references discloses of vapor vacuum deposited metal pigments and the declaration is related to the previously cited art no longer applied in the combination as previously defined.

### ***Response to Arguments***

Applicant's arguments filed 11/17/2008 have been fully considered but they are moot in view of the new ground(s) of rejection.

Regarding Hashizume, applicant argues this reference as not disclosing the claimed invention. This is acknowledged, however, the Examiner respectfully submits that Hashizume discloses that metal flakes coated with titanate can be useful in plastic because of the increased pigment stability (col. 2, lines 35-40) and is used only to show

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that a titanate coating is obvious and applicant provides no sound reasoning rebutting the Examiners position taken.

Since applicants amended claim 1, the obviousness-type double patenting rejection set forth in the previous office action is withdrawn.

### ***Conclusion***

It is to be noted that now claim 1 recites the limitation of original claim 2 in combination, however, the limitations of these claims were never defined before as such a combination, thus the above rejection is necessitated by applicants amendment.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sa

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793